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HAROLD B. WILLEY, CL

IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 875

SUN OIL COMPANY, *Petitioner,*

v.

ESSO STANDARD OIL COMPANY, *Respondent.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, Sun Oil Company, respectfully prays for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit to review a judgment of that Court entered on January 19, 1956.

A certified transcript of the record, including the proceedings in said Court of Appeals, and nine addi-

tional printed copies thereof, are furnished herewith, pursuant to Rule 21 of the rules of this Court, and particularly sub-paragraphs 3 and 4 thereof.

THE OPINIONS BELOW

The opinions of the Courts below and of the United States Patent Office tribunals all appear in the transcript of the record, at the pages indicated below.

The opinion of the Court of Appeals for the District of Columbia Circuit (R. 144-53) was filed January 19, 1956, and has not as yet been reported in the Federal Reporter System, but is published at 108 USPQ 161 and 704 O.G. 4.

The opinion of the District Court for the District of Columbia (R. 18-20) was filed April 15, 1954, and is reported at 122 F. Supp. 629.

The opinion of the Examiner-in-Chief of the Patent Office (R. 133-6), acting for the Commissioner of Patents, was filed May 7, 1951.

The opinion of the Examiner of Interferences of the Patent Office (R. 129-32), was filed August 1, 1950.

JURISDICTION

The grounds on which the jurisdiction of this Court is invoked are:

1. The United States Court of Appeals for the District of Columbia Circuit, by its decision herein, has decided an important question of Federal trademark law in a way which conflicts with comparable decisions of the United States Court of Customs and Patent Appeals. The question referred to has serious consequences for trademark owners generally. It is whether, in the absence of evidence of actual confusion between

two word trademarks, the likelihood of confusion should be determined (1) by considering the meaning, sound and appearance of the opposing marks *together,* weighing similarities in these three factors against disparities therein, or (2) by considering *separately* similarities in one or more of these factors, without weighing the similarities against the disparities between the two marks.

2. The United States Court of Appeals for the District of Columbia Circuit, by its decision herein, has improperly applied and *extended* the doctrine of *Morgan* v. *Daniels,* 153 U.S. 120, decided in 1894, which doctrine binds the District Court, in an action under Revised Statutes Section 4915, to accept findings of fact by the Patent Office *as to priority of invention* "unless the contrary is established by testimony which in character and amount carries thorough conviction." Under this *extended* doctrine, the District Court for the District of Columbia, is now bound to follow the final decision by the Patent Office even where that decision is a naked opinion as a conclusion of law and even where the several Patent Office tribunals had differing opinions on the precise conclusion.

3. The judgment that Petitioner seeks to have reviewed is dated and was entered on January 19, 1956 (R. 154).

4. A petition for rehearing of said judgment, which petition appears in the transcript of record at pages 155-67, was filed on February 17, 1956 (R. 155), and was denied without opinion on February 24, 1956 (R. 168).

5. The statutes conferring jurisdiction on this Court are Title 15, U. S. Code, Section 1122, Title 28, U. S.

Code, Section 1254, and Title 15, U. S. Code, Section 1071 (as amended July 19, 1952, coincident with the repeal of Revised Statutes 4915, 35 U. S. Code Section 63, *1946 Edition,* by The Patent Act of 1952, 35 U. S. Code Sections 1 *et seq.* 1953 Edition).

QUESTIONS PRESENTED

1. In deciding the issue of whether there is a reasonable likelihood of confusion between two trademarks consisting merely of words, where no attempt has been made to show actual confusion in trade, is the correct rule that enunciated and applied by the Court of Customs and Patent Appeals, which Court has repeatedly held that the sound, meaning and appearance of the marks should be considered *together,* and any similarities in one or two of these three factors should be weighed against the disparities in the other factors or factor, or is the correct rule that applied by the United States Court of Appeals for the District of Columbia Circuit in the instant case, wherein two marks that were found to be quite different in sound and wholly unlike in meaning were nevertheless held to be confusingly similar *solely* because of certain similarities in appearance, without weighing the similarities in appearance against the differences in sound and meaning?

2. Does the doctrine of *Morgan* v. *Daniels,* 153 U. S. 120, bind the District Court, in an action under now repealed Revised Statutes Section 4915, to follow a holding by the Patent Office that there is a likelihood of confusion between two trademarks, each consisting of a single word, where that holding was based *solely* on a finding of similarity in appearance, which finding was a *naked opinion* and a conclusion of law based on no evidence apart from the marks themselves?

3. In the situation presented by Question 2, but where there were in addition conflicting rulings in the Patent Office both on the issue of similarity in appearance and on the issue of likelihood of confusion, is the District Court bound to follow the latest in the series of conflicting rulings?

4. In the situation presented by Question 2, but where in addition the final Patent Office tribunal made findings of fact, based on evidence, that the two marks are quite different in sound and wholly unlike in meaning, but failed to weigh the similarity in appearance against the disparities in sound and meaning, is the District Court bound to follow the Patent Office's conclusion of likelihood of confusion?

5. Did not the enactment of the Administrative Procedure Act in 1946 which contained provisions for judicial review of Administrative Agencies specified in Title 5 U. S. Code, Section 1009(a) through (e), and Title 15 U. S. Code Section 1071, enacted July 5, 1946, relax if not abolish the doctrine of *Morgan* v. *Daniels?*

STATUTES AND RULE INVOLVED

Some of the statutes which were in effect on October 10, 1951, when the complaint in this action was filed in the District Court, have since been repealed and replaced, or amended. Where this has occurred the amended or new statute is hereafter quoted with footnote reference to the former U. S. Code citation.

TRADEMARK ACT OF 1946

Public Law 489, 79th Congress, Chapter 540, approved July 5, 1946; 60 Stat. 427.

Trademarks Registrable on the Principal Register

(15 U.S. Code 1052)

Sec. 2. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— * * * (d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers: *Provided,* * * *

APPEAL TO COURTS; REVIEW; ELECTION OF REMEDIES; COMMISSIONER AS PARTY

(15 U.S. Code 1071)[1]

Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, or any registrant who has filed an affidavit as provided in section 1058 of this title, who is dissatisfied with the decision of the Commissioner may appeal to the United States Court of Customs and Patent Appeals or may proceed under sections 145 and 146 of Title 35, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided,* That any party who is satisfied with the decision of the Commissioner shall, upon the filing of an appeal to the Court of

[1] As amended July 19, 1952.

Customs and Patent Appeals by any dissatisfied party, have the right to elect to have all further proceedings under section 146 of Title 35, by election as provided in section 141 of Title 35. The Commissioner of Patents shall not be a necessary party to an interpartes proceeding under section 146 of Title 35, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action. As amended July 19, 1952, c. 950, section 2, 66 Stat. 814.

APPEAL TO COURT OF CUSTOMS AND PATENT APPEALS

(35 U.S. Code, 141)[2]

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. July 19, 1952, c. 950, Sec. 1, 66 Stat. 802.

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[2] Replaced RS 4911, (35 U.S. Code Section 59a, 1946 Edition).

Civil Action in Case of Interference (35 U.S. Code, 146)[3]

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary

[3] Replaced RS 4915, 35 U.S. Code Section 63, 1946 Edition. RS 4915 had been amended in 1893, 1927, 1929, and 1939 as shown in Historical Note 1946 Edition U.S. Code Section 63.

party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. July 19, 1952, c. 950, Sec. 1, 66 Stat. 803.

Judicial Review Of Agency Action

(5 U.S. Code, 1009)

Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion.

Rights Of Review

(a) Any person suffering legal wrong because of any agency action or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

Form And Venue Of Proceedings

(b) The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

Acts Reviewable

(c) Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial review. Any preliminary, procedural, or intermediate agency action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the action meanwhile shall be inoperative) for an appeal to superior agency authority.

* * * * * * * * *

Scope of Review

(e) So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold unlawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 1006 and 1007 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject

to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error. June 11, 1946, c. 324, Sec. 10, 60 Stat. 243.

Rule 23.1

Patent Office Rules in Trademark Cases

This rule is quoted below in the form it bore during the opposition proceedings in the case at bar. It is now Rule 2.117, and has been somewhat changed, but the changes are largely formal.

23.1 Federal Rules of Civil Procedure

Except as otherwise provided, procedure and practice in contested or inter partes proceedings shall be governed by the Rules of Civil Procedure for the District Courts of the United States wherever considered applicable and appropriate.

Any junior party in an interference, the opposer in an opposition proceeding, the petitioner in a cancellation proceeding, and the applicant to register as a concurrent user, shall be deemed to be in the position of plaintiff, and the other parties to such proceedings in the position of defendants with respect thereto. The notice of opposition and the petition to cancel, and the answers thereto, correspond to complaint and answer; there are no equivalent pleadings in interferences and in concurrent use proceedings when no answer is required, the issues in such cases being determined by the respective applications or registrations involved. The taking of testimony and the final hearing correspond to trial, and the assignment of times for taking testimony and for final hearing to setting a case for trial.

STATEMENT OF THE CASE

This is a suit seeking authorization to the Commissioner of Patents to issue a certificate of trademark registration to Sun Oil Company, Petitioner here, upon its application for registration of its trademark "Sunvis" for lubricating oils. The jurisdiction of the United States District Court for the District of Columbia is based upon 35 U.S. Code 146 which replaces Revised Statutes Section 4915 (35 U.S. Code 63, 1946 Edition), and is expressly made applicable to trademark cases by Section 21 of the Lanham Trademark Act (15 U.S. Code 1071). Petitioner's right to registration is asserted under Section 2 of the Lanham Act (15 U.S. Code 1052). The foregoing statutes are set forth in full above, except for Section 2 of the Lanham Act, as to which only the pertinent portions are quoted.

Petitioner's application for registration of "Sunvis" (R. 54-63) was filed in the United States Patent Office on December 18, 1946, Serial No. 514,508, claiming continuous use since November, 1944. It was duly prosecuted, passed to publication, and published in the Official Gazette of August 17, 1948.

Thereupon, Esso Standard Oil Company, Respondent here, filed in the Patent Office a Notice of Opposition to the registration of Petitioner's mark (R. 65-7). The opposition was based on Registration No. 162,372 issued December 12, 1922 (R. 137), which registration has been duly renewed and is now owned by Respondent. This registration covers the trademark "Univis" for lubricating oils. The real foundation of the opposition was set forth in the Notice of Opposition as follows (R. 66):

> "(3) The mark for which applicant seeks registration is SUNVIS, which differs in spelling from

> opposer's trademark UNIVIS by only one letter and which is a mark so similar to opposer's trademark in appearance and sound as to be likely to cause confusion in the public mind and deceive purchasers."

An answer was filed by Petitioner (R. 68-71), and depositions were taken by both parties (R. 75-128).

The substantial question in issue both in the Patent Office and the District Court was whether the marks "Sunvis" and "Univis" are sufficiently similar to raise a reasonable likelihood of confusion in the public mind. There has never been any question as to the priority of use of "Univis" over "Sunvis". There has never been any contention of actual confusion in trade, even though, when the taking of depositions commenced in the opposition proceeding, the two marks had been in concurrent use on a wide scale for nearly five years. In the proceedings below, Petitioner contended that the goods of the parties are specifically different and are sold and used for quite different purposes, but no reliance is now placed upon that contention. It is now conceded that the marks are used on goods of the same descriptive properties.

Respondent was in the position of plaintiff in the opposition proceeding, and its Notice of Opposition corresponded to a complaint (Patent Office Rule 23.1, quoted supra). As expected, Respondent pleaded as part of its case, confusing similarity between "Sunvis" and "Univis" in "appearance and sound" (supra, p. 12). There was no pleading of similarity in meaning. In support of its pleading, Respondent simply proved its prior registration and, since the mark is a coined word, its derivation from conventional English words, thereby establishing its meaning as well as its sound.

The mere proof of the prior registration sufficed, under the accepted Patent Office practice, to sustain Respondent's burden of proof on the issue of similarity in appearance. *Carrier Corporation* v. *Hudson Motor Car Company*, 166 MS 863, 67 USPQ 122, 123, decided October 17, 1945, by the First Assistant Commissioner of Patents.

"Univis" is derived from the words "uniform" and "viscosity" (R. 52; Def. Ex. 2, R. 138), and is a *three*-syllable word, pronounced and read as "yo͞o'nĭ-vis", to accord with the pronunciation of "uniform" (yo͞o'nĭ-fôrm). "Sunvis" is derived from Petitioner's corporate name and the word "viscosity", and is a *two*-syllable word, pronounced and read as "sŭn'vis".

All of the tribunals below have unanimously held that the two marks are, to use the language of the Examiner-in-Chief (R. 134), "quite different in sound and wholly unlike in meaning." These are findings of fact based on evidence.

There is not a single shred of evidence in the record before the Patent Office, nor in the record before the District Court, bearing upon the matter of similarity in appearance of "SUNVIS" and "UNIVIS", other than the bare marks themselves. Indeed, it is difficult to see what evidence *could* have been presented by either party on this point, unless it would be the opinion of a psychologist or a market analyst as to the effect of the two marks on an average human eye and mind.

It follows from the foregoing that *all* of the rulings below on the issue of similarity in appearance of the two marks were *naked opinion*, and *not* findings of fact based on evidence.

The Examiner of Interferences dismissed the opposition on the ground that there was no reasonable likelihood of confusion. It is clear from the opinion of the Examiner of Interferences (R. 129-32), that, in arriving at his decision, he weighed together the factors of appearance, sound and meaning. The gist of his opinion is contained in the following sentence (R. 131):

> "While it is true, as the opposer contends, that the marks differ in composition only as to one letter in the initial portions thereof, however, this difference together with the arrangement of the letters is believed to result, as contended by the applicant, in terms which are different in appearance and sound, and so entirely different in meaning as to obviate any confusing similarity between them, and enable their concurrent use for the products involved without any reasonable likelihood of confusion in trade."

Respondent appealed to the Commissioner of Patents, who, acting through the Examiner-in-Chief, reversed the Examiner of Interferences. The Examiner-in-Chief did not weigh together the factors of appearance, sound and meaning, but instead based his reversal *solely on the issue of appearance*, considered by itself. The significant paragraph of his opinion is as follows (R. 134-5):

> "Opposer urges that the two marks are confusingly similar in that both have the same suffix 'vis' and that the prefixes thereto 'uni' and 'sun' differ by only one letter. The difference in one letter is not considered particularly significant insofar as sound and meaning of the prefixes are concerned, since in the particular combinations of letters, the results are terms which are quite different in sound and wholly unlike in meaning. However, the two marks in their entireties are similar

> in appearance. The latter parts are identical, as has been pointed out, and the prefixes consist of only three letters each, both having the same two letters 'un' in the same order. Similarity in appearance with the identical suffixes is considered sufficient to render the two marks confusingly similar."

Petitioner was then faced with a choice of remedies, either to appeal to the Court of Customs and Patent Appeals on the Patent Office record, or to seek a review *de novo* under Revised Statutes Section 4915. Feeling that the Patent Office record could be strengthened by further evidence, Petitioner elected the latter course. The further evidence consisted chiefly of Plaintiff's Exhibits No. 3 (offered at R. 32 and received in evidence at R. 36) and No. 4 (R. 36), although there was also a little testimony by one new witness on behalf of Petitioner (R. 36-40).

In its Informal Memorandum, the District Court specifically approved and adopted the above-quoted holding of the Examiner of Interferences (R. 19-20). In its formal Findings of Fact, the District Court confirmed this holding as follows (R. 21):

> "7. There is not sufficient similarity in appearance, sound or meaning between the trade-marks 'SUNVIS' and 'UNIVIS' when used concurrently on lubricating oils to reasonably cause likelihood of confusion in trade."

Respondent appealed to the Court of Appeals, which reversed the District Court, principally on the ground that the District Court was bound to accept the final Patent Office ruling by the Examiner-in-Chief, no new evidence having been adduced in the District Court "which could have been in any way persuasive upon it

to arrive at a different finding from that of the Patent Office's final reviewing officer." (Opinion, R. 151.)

As has been stated, Respondent sought to sustain its burden of proof in the Patent Office on the issue of similarity in appearance, merely by proving its registration. Similarly, in the District Court, Petitioner contented itself with bringing the opposing marks properly before the Court, and leaving it to the Court to judge as to their similarity. It is difficult to see what else Petitioner could or should have done. Questions as to the meaning and sound of words are susceptible of proof by evidence, and such evidence appears in this record. But the matter of appearance to the mind's eye is not susceptible of proof in such manner. Yet the Court of Appeals, in the following passage of its opinion, squarely placed on Petitioner the impossible burden of proving the negative of the proposition advanced by the Examiner-in-Chief, that the two marks are confusingly similar in appearance (R. 149-151):

> "Apart from this, we have examined the record before the District Court to ascertain whether there was evidence which could have thoroughly convinced the court that the Patent Office's finding that the similarity in appearance would be confusing was unwarranted. Although the District Court had before it the full record of the Patent Office proceedings consisting of depositions and documents, it also received some new evidence not before the Patent Office. * * * [The Court here considered the new evidence.] * * * Obviously there is nothing in this evidence which would tend to show that the marks 'UNIVIS' and 'SUNVIS' are not confusingly similar in appearance. There was thus no new evidence before the District Court which could have been in any way persua-

> sive upon it to arrive at a different finding from that of the Patent Office's final reviewing officer."

The Court of Appeals, in its opinion, assumed, quite erroneously, we think, that the District Court based its decision on a single factor wholly different from those discussed above. The Court of Appeals said (R. 148-9):

> "The District Court seems to have disagreed with the Patent Office for only one reason. It found that 'No similarity in appearance is found between "SUNVIS" and "UNIVIS" where the dominant prefix portions of the marks are entirely different in meaning or significance.' It thus appears that the District Court based its finding of dissimilarity of appearance entirely on the fact that the marks, or their prefix portions, are dissimilar in meaning. No other reason for its conclusion is suggested in its findings or its informal memorandum."

The quoted language in the foregoing passage appears as Finding No. 6 in the District Court's Findings of Fact (R. 21). It is based on a sentence in the District Court's Informal Memorandum (R. 19, last full paragraph, last sentence). But that sentence was stricken from the Informal Memorandum by the Amendment dated May 3, 1954 (R. 20), and apparently was inadvertently retained in the previously prepared Findings of Fact which were filed the same day (R. 20).

It is submitted that the facts are that (1) the District Court reached an independent conclusion, based solely on its examination of the two marks, that there is little similarity in appearance between them, and (2) the District Court then weighed this slight similarity in appearance against the large disparities in sound and meaning, and thus reached the conclusion that there

is no reasonable likelihood of confusion in trade. In so doing, the District Court found itself in full agreement with the Examiner of Interferences.

Although it is fully recognized that this Court will not review a case merely to correct a factual error below, yet we feel that a few words in support of the District Court's conclusion may not be amiss. The two marks here in issue are single words, nothing more. It is submitted that when one reads a single word, he reads it, *not* by individual letters, but as a whole or by syllables, *as it is pronounced.* It is submitted also that the mind's eye sees words as they are pronounced and read, rather than as they are spelled, letter by letter. It is submitted further that these are facts of which judicial notice can and should be taken. If these facts be accepted, it follows that it is difficult, if not impossible, to divorce the appearance of words from their *sounds.* This is true even though we also accept the conclusion of the Court of Appeals in its opinion in this case that: "Many words different in meaning may look enough alike to be confusing to the public if used as a mark." (R. 149.)

Applying the foregoing principles to the case at bar, "Univis", as has been stated, is a three-syllable word, whereas "Sunvis" is a two-syllable word. The letter "u" in "Univis" spells a diphthong ending with the long vowel "o͞o"; and in "Sunvis" the same letter spells the short vowel "ŭ" as in "but". The letter "n" falls in the *second* syllable of "Univis" and in the *first* syllable of "Sunvis". The two marks, *considered as they are read* and taken in their entireties, plainly do not look alike, as is shown by the syllabic display below:

U-NI-VIS
SUN-VIS

The supposed similarity found by the Examiner-in-Chief was arrived at only by anagrammatical analysis (supra, p. 15). Accordingly, it is submitted that the Examiner of Interferences and the District Court were correct in holding that there is no confusing similarity in appearance between "Sunvis" and "Univis".

ARGUMENT

The Conflict of Decision Between the Court of Appeals and the Court of Customs and Patent Appeals

It is of the utmost consequence to the orderly administration of the trademark laws that the Court of Customs and Patent Appeals and the Court of Appeals for the District of Columbia Circuit should see eye-to-eye on the interpretation and application of the trademark statutes. The Court of Customs and Patent Appeals is the direct avenue of appeal from decisions of the Commissioner of Patents but the dissatisfied party may elect instead to proceed by way of a suit in equity, all as provided in 15 U.S. Code Section 1071. In *ex parte* proceedings such suits must be brought against the Commissioner in the District Court for the District of Columbia. In *inter partes* proceedings, as a practical matter, such suits are frequently brought in the District Court for the District of Columbia, as was the instant case. But if the dissatisfied party elects to appeal to the Court of Customs and Patent Appeals, the satisfied party may nonetheless terminate that appeal and transfer the case into the District Court for the District of Columbia, by proceeding under 35 U.S. Code Sections 141 and 146, as permitted by 15 U.S. Code Section 1071, as amended. All of these statutes are quoted above.

In view of the foregoing, if the Court of Customs and Patent Appeals follows one rule, and the Court of Appeals for the District of Columbia Circuit follows a different rule, the ultimate disposition of the case may be entirely different depending upon an arbitrary selection of the avenue of review.

The importance of trademarks in our modern industrial economy needs no stressing. But it may be well to point out the difficulties that lie in the way of a newcomer making a *bona fide* effort to adopt a mark that does not trespass upon any prior mark, and how greatly those difficulties are increased by the rule adopted by the Court of Appeals in the case at bar.

In the instant case, Petitioner adopted the mark "Sunvis" with full knowledge of the prior use of "Univis" by Respondent. It did so after investigation by its Patent Department and with complete conviction that it was not trespassing in any way on Respondent's rights. Petitioner used the mark "Sunvis" openly and widely for nearly four years before the Notice of Opposition was filed by Respondent, and during that entire period Respondent made no complaint. Indeed, no charge of trademark infringement was made by Respondent up to the day of the trial, February 2, 1954 (R. 27), over nine years after "Sunvis" was first used (R. 55). (Spurdle testimony, R. 36-40.)

In selecting a word mark, the newcomer customarily makes a search among the trademark records of the Patent Office. If a prior mark is found that is the same as or similar to his proposed mark, the newcomer starts again. With the great development of trademark usage in this country, and the national scope that

is given to a registration even if the prior mark is used in only two states, it is a common experience among trademark attorneys to find that it is necessary to repeat this process many times. Finally, a proposed mark is developed as to which there appears to be no conflict. The English language being what it is, and American trademark customs being what they are, this does not usually mean that no prior mark resembles the chosen mark; it merely means that the trademark attorney reaches the conclusion that no prior mark is *sufficiently close* to the chosen mark to be *likely* to cause confusion in trade.

In reaching this conclusion, the trademark attorney must of course rely upon the decisions that have been handed down by the Courts under similar circumstances. Where the trademarks are word marks, and there is no evidence of actual confusion, it is settled law that the likelihood of confusion will be resolved by comparing the two marks as to sound, meaning and appearance. This settled law was recognized by the Court of Appeals in its opinion (R. 148). But it is still of the utmost importance as to *how* this comparison is to be made, and it is precisely here that the Court of Appeals has approved a rule that is in direct conflict with the rule of the Court of Customs and Patent Appeals.

The Court of Customs and Patent Appeals has repeatedly ruled that the three factors of sound, meaning and appearance should be considered *together,* and any similarities in one or two of these three factors should be weighed against disparities in the other factors or factor. It is submitted that this rule is well founded in both logic and common sense, and provides a reasonable and workable standard of comparison. It makes

the task of the trademark attorney in approving a new mark one that can be competently discharged without recourse to a crystal ball. The contrary rule adopted by the Court of Appeals, on the other hand, makes the task of the trademark attorney a superhuman one, since he must either bend over backward by disapproving any selected mark that bears any resemblance in any one of these three factors to any prior mark, or else guess as to whether the resemblances that he knows exist will be "considered sufficient to render the two marks confusingly similar", to use the language of the Examiner-in-Chief in the case at bar (supra, p. 15).

The Court of Customs and Patent Appeals well stated its rule in *Coty, Inc.* v. *Perfumes Habana, S.A.*, 190 F. 2d 91 (C.C.P.A. 1951), as follows (at p. 94):

> "The issue of confusing similarity must be resolved by comparing the appearance, sound and meaning of the respective marks and evaluating those three factors in their entirety as assembled in each contested mark."

To the same effect is the very recent opinion of the Court of Customs and Patent Appeals, released January 16, 1956, only three days before the opinion of the Court of Appeals in the case at bar, in *Holiday Casuals* v. *M. Beckerman & Sons, Inc.*, 228 F. 2d 224, in which the Court said (at p. 226):

> "Considering the sound, meaning and appearance of the marks together, we find that the similarities in sound and appearance of the marks are not sufficiently great to outweigh the great disparity in meaning, and thus we do not believe that there is a likelihood of confusion between the marks."

In the instant case, it is submitted that the Examiner of Interferences and the District Court acted correctly in "evaluating those three factors in their entirety as assembled in each contested mark", and reached the sound conclusion that there is no reasonable likelihood of confusion between the marks (supra, pp. 15, 16). To the contrary, the Examiner-in-Chief considered similarity in appearance *by itself*, without weighing it against the dissimilarities in sound and meaning (supra, p. 15). It is submitted that this constituted clear error, sufficient by itself to justify the District Court in reversing the Examiner-in-Chief, and re-establishing the holding of the Examiner of Interferences. Yet the Court of Appeals held that the District Court was bound to accept the holding of the Examiner-in-Chief, and thus, in effect, approved the practice of separate consideration of a single one of these three factors.

The Extension of the Doctrine of Morgan v. Daniels

The extension of the doctrine of *Morgan* v. *Daniels*, 153 U.S. 120, promulgated by the Court of Appeals in its opinion in the instant case, has important consequences not only for trademark law and patent law, both of which are directly affected by the interpretation of Title 35 U.S. Code Section 146, but also for administrative law generally. The extended doctrine greatly enlarges the class of administrative decisions that are immune from judicial review.

The doctrine of *Morgan* v. *Daniels* was set forth in 1894 in the following paragraph of the opinion of Mr. Justice Brewer (153 U.S. 120, 125):

> "Upon principle and authority, therefore, it must be laid down as a rule that where the question

> decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. Tested by that rule the solution of this controversy is not difficult. Indeed, the variety of opinion expressed by the different officers who have examined this testimony is persuasive that the question of priority is doubtful, and if doubtful the decision of the Patent Office must control."

Looked at superficially, it must be conceded that there appears to be an exact parallel between *Morgan* v. *Daniels* and the case at bar. Here, as there, there has been a "variety of opinion expressed by the different officers". Here, as there, Petitioner is endeavoring to upset the final holding of the Patent Office. Here, the District Court had before it, confining ourselves for the moment to the issue of *similarity in appearance* of the two marks, no evidence that was not before the Patent Office. Yet it is submitted that there is in fact a substantial difference between the two situations.

As clearly appears from the opinion in *Morgan* v. *Daniels,* the situation there involved was one of the weight to be given to parole testimony. Nothing of the sort is present in the case at bar. In the instant case, there is not the slightest conflict as to the pertinent facts. Moreover, on the issue of similarity in appearance, as to which alone has there been any "variety of opinion" in the case at bar, there is absolutely *no evidence whatsoever* apart from the bare marks themselves.

We therefore come down to the question whether a final decision by the Patent Office, which decision is not based, and does not purport to be based, on evidence, but is a conclusion of law, indeed a *naked* opinion, is entitled to the same deference as an administrative decision which evaluates and is based on evidence.

All legal controversies must end somewhere and, from the standpoint of brevity of proceedings, there have been those who advocate having trademark oppositions and patent interferences end in the Patent Office or the Court of Customs and Patent Appeals. But, to reduce the likelihood of injustice due to unfortunate Patent Office decisions, Congress has seen fit to provide for a review *de novo* by suit in equity under 35 U.S. Code Section 146. And to safeguard its citizenry against the over-exercise of administrative power Congress has seen fit to guarantee judicial review of Agency acts by 5 U.S. Code Section 1009. It is altogether fitting and proper to require the dissatisfied party to produce convincing evidence that the Patent Office is in error as to a finding of fact based on evidence. But here the Patent Office's finding is a naked opinion, which in the nature of things can neither be supported nor controverted *by either party* save by argument directed to the intangible result of impression on the mind's eye.

It may well be that some limitation must be placed on a review *de novo* of Patent Office determinations and it may well be that a fitting limitation is that imposed by some measure of the burden of proof on the complaining party. But the burden of proof under the 1894 doctrine of *Morgan* v. *Daniels* (supra, p. 24) is not a fitting limitation applicable to all situations in patent and trademark suits. As applied by the Court

of Appeals in this action the doctrine denies judicial review to the dissatisfied party who, as here, challenges a Patent Office conclusion of law which is a mere naked opinion. The doctrine also fails to recognize the posture of the contesting parties and the burden of proof on them before the Patent Office. Here Respondent clearly had the burden of proof in the Patent Office of establishing similarity in appearance between the two marks under Trademark Rule 23.1 (supra, p. 11). Thus the decision of the Patent Office was in favor of the party having the burden of proof. If, under such circumstances, a naked opinion cannot be challenged, we have indeed a failure of justice.

It is submitted that administrative law in general, and Patent Office practice in particular, will become a morass of uncertainty and injustice if judicial review of naked opinions by administrative agencies be denied, and especially if it be denied where the decision sought to be reviewed was favorable to the party having the burden of proof.

Finally it is submitted that if an administrative conclusion of law cannot be challenged by the dissatisfied party, not only does the right of review *de novo,* guaranteed by Title 15 U.S. Code Section 1071 become an empty right but the guarantee of judicial review of Agency acts given by Title 5 U.S. Code Section 1009 becomes a nullity. The 1894 doctrine of *Morgan* v. *Daniels* should not accomplish these results. It should be remembered that R.S. 4915, as it was there construed in 1894, was successively amended in 1927, 1929 and 1939 before it was repealed in 1952. In 1946 the Administrative Procedure Act expressed the clear intent of Congress to safeguard the public against abuse of Agency powers. Also in 1946 the Trade Mark

Act, in Title 15 U.S. Code Section 1071, expressly granted the right of review, without limitation, to the trademark applicants such as Petitioner. In these circumstances the doctrine of *Morgan* v. *Daniels* should not be extended, indeed, it should be modified and relaxed as Congress intended.

CONCLUSION

The decision below is incorect and far-reaching in its implications. The questions presented are important not only to trademark owners but to the public generally. The only review possible is by this Court.

It is earnestly urged that the petition be granted.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No.

SUN OIL COMPANY, *Petitioner*

v.

ESSO STANDARD OIL COMPANY, *Respondent*

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

Introduction

Respondent, Esso Standard Oil Company, respectfully submits that the Petition of Sun Oil Company for a Writ of Certiorari to the Court of Appeals for the District of Columbia Circuit should be denied.

The petition fails to set forth any substantial ground upon which it should be granted. It does not set forth any conflict of decisions of Courts of Appeals on the same matter; it does not present an important question of federal law which has not been or should be

settled by the Supreme Court; it does not show that the Court of Appeals for the District of Columbia Circuit has decided a federal question in a way which conflicts with applicable decisions of the Supreme Court; and it does not indicate that exercise of the supervisory power of the Supreme Court is sought or warranted. In short, it merely seeks a reconsideration by the Supreme Court of the decision of the Court of Appeals.

Official Reports

The petitioner's brief omits the citation of the final decision of the Patent Office in the case at bar, that being:

> Esso Standard Oil Company v. Sun Oil Company, 89 United States Patents Quarterly 331; 41 Trademark Reporter 629.

Petition for Rehearing Denied

The petitioner sought a rehearing before the Court of Appeals (R. 158) on the precise point on which certiorari is now sought; namely, whether or not the decisions of the Supreme Court in *Morgan* v. *Daniels*, 14 S.Ct. 772, 153 U.S. 120, and that of the Court of Appeals, itself, in *Abbott* v. *Coe*, 71 App. D.C. 195; 109 F.2d 449 (both pertaining to the presumption of correctness of the action of one of the executive departments of the Government) are applicable to the instant case. In the petition for rehearing, as in the present petition for certiorari, it was urged by petitioner that the Court should apply to the case at bar the decisions of the Court of Customs and Patent Appeals in *Coty, Inc.* v. *Perfumes Habana S.A.*, 190 F.2d 91, and *Holiday Casuals* v. *M. Beckerman & Sons, Inc.*, 228 F.2d 224 pertaining to the criteria

to be employed in determining confusing similarity of trademarks.

After due consideration of the petition, it was denied by the Court of Appeals (R. 168).

JURISDICTION

The action was brought by petitioner in the District Court for the District of Columbia against the Commissioner of Patents and the respondent under the provisions of Revised Statutes, Section 4915; Title 35 United States Code Section 63 (R. 3), (which was made applicable to trademark cases by Title 15 United States Code Section 1071, although the latter section was not pleaded in the complaint).

Issue was joined by the respective answers filed October 23, 1951, on behalf of the Commissioner of Patents, and December 14, 1951, on behalf of respondent, Esso Standard Oil Company. Accordingly, there is no jurisdiction whatever under The Patent Act of 1952 since that Act did not become effective until January 1, 1953.

The question of statutory jurisdiction is germane to the question presented on petition for certiorari in view of the fact that *Morgan* v. *Daniels,* supra, and *Abbott* v. *Coe,* supra, were both decided under the statute under which the present action was brought, namely Revised Statutes, Section 4915 (35 United States Code Section 63). Petitioner seeks review by certiorari on the erroneous representation that the statute, Title 15 United States Code Section 1071, (as amended to be effective January 1, 1953), which was not pleaded, and was not even effective when issue was joined, has changed the doctrine announced by the Supreme Court in *Morgan* v. *Daniels,* supra, and fol-

lowed by the Court of Appeals in *Abbott* v. *Coe,* supra. In addition, petitioner seeks to inject at this late stage, The Administrative Procedure Act, Title 5 United States Code Sections 1009(a) through (e), although that statute was in force at the time the complaint was filed it was not pleaded and no jurisdiction was alleged or established under that Act during the pendency of the action below.

It is clear, therefore, that jurisdiction does not lie with respect to the statutes set forth in the petition (p. 6 to 10, incl.).

PETITIONER ELECTED REMEDY IN DISTRICT COURT RATHER THAN COURT OF CUSTOMS AND PATENT APPEALS

The petitioner's argument (p. 20) begins on the premise that the United States District Courts (and the respective Courts of Appeals) should apply the same criteria of "confusing similarity" as well as the criteria of "likelihood of confusion" as the Court of Customs and Patent Appeals, particularly in view of the fact that statutory provision is made for initial election of forum by appellant and transfer of jurisdiction (at the option of the appellee) from the Court of Customs and Patent Appeals to a United States District Court in which jurisdiction over appellee may be obtained in the event appellant elects to appeal to the Court of Customs and Patent Appeals.

It must be borne in mind that petitioner, in the present case, initially elected the District of Columbia as the forum (no appeal having been taken to the Court of Customs and Patent Appeals, R. 5, par. 16). Petitioner should not, therefore, be heard to complain if it chose a forum which applies criteria with which petitioner does not agree.

There is no conflict, however, between the Court of Appeals for the District of Columbia and the Court of Customs and Patent Appeals as to the criteria of "confusing similarity" of marks or "likelihood of confusion" which will bar registration to a newcomer in the field. The consistency of criteria will be pointed out hereinafter.

THE QUESTIONS

The questions presented by petitioner (Petition, pp. 4, 5) should be clarified by pointing out that no trademark may be registered by the Commissioner of Patents if there is likelihood of confusion as to the origin of the goods bearing the mark sought to be registered. Many facts are considered in determining "likelihood of confusion", only one of those facts being the "confusing similarity" which was clearly expressed by the Supreme Court in *McLean* v. *Fleming,* infra, and followed by the Patent Office and the Court of Appeals in the present case. The petitioner has thus glossed over the ultimate question of "likelihood of confusion" as the basis upon which registration of the mark "SUNVIS" was refused by the Commissioner of Patents under the Trademark Act of 1905.

The question of presumption of correctness of the decision of the administrative agency on the technical question of "likelihood of confusion", and the included factors of "similarity of marks", "similarity of goods", "channels of trade", "classes of purchasers", "territorial extent of markets", "priority of use", etc., is really the only question which could be raised in a suit by petitioner under Revised Statutes Section 4915. The Court is to examine the merits of the case only for

the purpose of determining whether or not the Commissioner of Patents committed clear error as a matter of law or was arbitrary or capricious if it involves his discretion.

ADMINISTRATIVE RULING

The Supreme Court, in *Morgan* v. *Daniels,* supra, decided once and for all that the action of an executive department of the Government is not to be set aside except where the evidence is sufficient in character and amount to carry thorough conviction that clear *error* has been committed by the agency charged with the administration of the statutes. To do otherwise would be to substitute the judgment of the judiciary for that of the technical experts in the executive branch of the Government, thereby destroying the separation of powers inherent in our Government. Thus it is that the burden is on the petitioner to show by more than a mere preponderance of the evidence that the Commissioner of Patents committed clear error, if the District Court is to vacate the action of the Commissioner. In other words, petitioner must show that the Commissioner did not employ the proper criteria to the case at bar in determining that the marks UNIVIS and SUNVIS, as applied to identical goods, are confusingly similar within the meaning of the trademark registration statutes.

ADMINISTRATIVE PROCEDURE ACT NOT APPLICABLE

The question presented cannot possibly involve the Administrative Procedure Act inasmuch as there was specific provision under Revised Statutes Section 4915 for review of the rulings of the Commissioner of Patents on the merits of registrability of trademarks and, therefore, review of such determinations is pre-

cluded by the terms of Title 5 United States Code Section 1009.

COUNTERSTATEMENT OF THE CASE

The petitioner filed application to register the trademark SUNVIS for lubricating oils under the Trademark Act of 1905 (not under Section 2 of the Trademark Act of 1946 as represented in the first paragraph, page 12, of the petition before this Court). (R. 3, par. 7).

Respondent duly opposed the registration sought by petitioner, on the ground that SUNVIS, as applied to lubricating oils, is so similar to respondent's previously used and registered trademark UNIVIS for lubricating oils, as to be likely to cause confusion in the public mind and deceive purchasers (R. 66, pars. 3, 4 and 5).

During the opposition proceeding in the Patent Office, petitioner contended that its goods were specifically different from respondent's goods, but at the trial respondent proved that petitioner had extended its use of the mark SUNVIS to lubricating oils which are *directly* competitive with and used for the *identical purposes* for which respondent sells its goods under the mark UNIVIS. This expansion of use of the mark is now conceded by petitioner (Petition, p. 13). Even if the final decision in the Patent Office was based upon the fact that petitioner's goods and respondent's goods, on the record before it, were specifically different, the correctness of the Patent Office determination of *likelihood* of confusion is *strengthened* by the new fact adduced at the trial de novo.

Respondent not only proved its prior registration, but also established likelihood of confusion by the testimony of five witnesses (R. 75 to 103, incl.) who were cross-examined by counsel for petitioner. (The petition, page 13, represents that respondent "simply proved its prior registration", and from that erroneous representation proceeds to the contention that all of the rulings of the Patent Office "were *naked opinion*, and *not* findings of fact based on evidence"). This evidence was strengthened by oral testimony in open court (R. 4452, Deft. Exhs. 1, 2 and 5, pp. 137, 138, 140) as to increased likelihood of confusion due to petitioner's expanded use of the mark.

Except for the argumentative matter injected into the Statement of the Case in the petition (pp. 14 to 20, incl.), and the foregoing restatement of certain points in the case, respondent's counterstatement of the case may be summarized by reiterating that petitioner is merely dissatisfied with the ruling of the Patent Office and the Court of Appeals on the question of registrability of SUNVIS over UNIVIS under the Trademark Statute.

RULE IN COURT OF CUSTOMS AND PATENT APPEALS HOLDS SIMILARITY IN ONE FEATURE SUFFICIENT TO BAR REGISTRATION

The burden of petitioner's argument appears to revolve around a contention that the Court of Customs and Patent Appeals will permit registration of a trademark where there is similarity only in appearance of two contesting marks, whereas the Court of Appeals for the District of Columbia will not permit registration under those circumstances.

Suffice it to say that for the two decisions of limited application cited by petitioner (*Holidebs* v. *Honeydebs*, supra, and *Fleur De Cherigan* v. *Lorigan and L'Origan*, supra), respondent relied below and relies here upon the twelve decisions of the Court of Customs and Patent Appeals relied upon by the Patent Office (R. 135) and two of those decisions relied upon by the Court of Appeals (*Pediglo* v. *Pechglo, infra,* and *Artcraft* v. *Edgecraft,* infra).

In addition, respondent respectfully calls attention to the holdings of the Court of Customs and Patent Appeals in *Celanese Corporation of America* v. *E. I. DuPont De Nemours & Company,* 154 F. 2d 143, 69 USPQ 69 (*Clarifoil* v. *Clar-Apel*), and *John H. Breck, Inc.* v. *Colgate-Palmolive Company,* 225 F. 2d 246; 107 USPQ 8 (*Breck* v. *Brisk*), in each of which the court made it clear that similarity in any *one* of the elements of sound, appearance or significance is sufficient to bar registration. This is particularly applicable where, as here, the goods of the parties are identical and the registrant-opposer is the long prior user of the mark in suit.

PATENT OFFICE DECISION SUPPORTED BY EVIDENCE OF LIKELIHOOD OF CONFUSION

The petitioner ignores the fact that the final decision of the Patent Office (R. 133 to 136, incl.) by an eminent authority, Hon. P. J. Federico (who is the author of the Commentary on the Patent Act of 1952 appearing at 35 USC 1), adheres to the principles laid down by the Court of Customs and Patent Appeals in determining confusing similarity of UNIVIS and SUNVIS. Mr. Federico said "Similarity in appearance with the identical suffixes is considered sufficient to render the two marks confusingly similar." He

went on to cite many cas of the Court of Customs and Patent Appeals an other Federal courts in harmony with the stated inciple. One of those cases involved the marks "A TCRAFT" and "EDGE-CRAFT" and the facts in that case were quite similar to those in the present se.

The principle relied u on by Mr. Federico is also supported by the very se in which petitioner says the rule is well stated b the Court of Customs and Patent Appeals, namel *Coty, Inc.* v. *Perfumes Habana, S.A.,* 190 F.2d 91, wherein the court said (p. 93):

> "The suffix porti of this term 'Cherigan' is identical with the s fix portion of the opposer's mark 'L'Origan', an in sound this term is believed to be so nearly like t e opposer's mark 'L'Origan' as clearly to be onfusingly similar thereto. Similarity in sound lone is sufficient to determine confusing similari between marks. Marion Lambert, Inc., v. O onnor [O'Connor], 477 O.G. 244, 86 F. 2d 980, [2] C.C.P.A. [781]; McKinnon & Company v. Hy s Oils, Inc., 484 O.G. 746, 88 F. 2d 699, [24] C.C P.A. [1105]."

The facts of the pr ent case (*Univis* v. *Sunvis*) bring it within the foll ing language of the Court's decision in the *Coty* ca , supra:

> "The two words ere in issue are identical in appearance and so d in so far as the applicant has appropriated t e last five letters of the eight letters of which ap llant's entire marks are comprised."

In view of the fact t t five of the *six* letters of the marks UNIVIS and SUNVIS are identical in appearance and arra ement and there is notable

similarity in sound, the Court's decision in the *Coty* case, supra, is particularly applicable, not only as to the law but also as to the facts.

The Court of Appeals for the District of Columbia Circuit, in the instant case, not only followed the precedents announced by the Court of Customs and Patent Appeals in the *Artcraft* v. *Edgecraft* case (*Kenosha Full Fashioned Mills* v. *Artcraft Hosiery Co.*, 161 F.2d 751 (CCPA 1947)) and the *Pediglo* v. *Pechglo* case (*Vanity Fair Mills* v. *Pedigree Fabrics*, 161 F.2d 226 (CCPA 1947)), but also its own precedent in *Guggenheim* v. *Cantrell & Cochrane*, 56 App. D.C. 100; 10 F.2d 895, wherein the court said:

> " 'the points of similarity are of greater importance than the points of difference' when a new mark is measured against a well known and established mark."

This principle finds its foundation in the early decision of the Supreme Court in *James H. McLean* v. *Cochran Fleming*, 96 U.S. 245, 24 L. Ed. 828, wherein Mr. Justice Clifford stated (at p. 831):

> "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases. All that courts of justice can do, in that regard, is to say that no trader can adopt a trade-mark, so resembling that of another trader, as that ordinary purchasers, buying with ordinary caution, are likely to be misled."
>
> * * * * *
>
> "Much must depend, in every case, upon the appearance and special characteristics of the entire device; but it is safe to declare, as a general rule, that exact similitude is not required to con-

stitute an infringement or to entitle the complaining party to protection. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer's device, is such as would be likely to mislead one in the ordinary course of purchasing the goods, and induce him to suppose that he was purchasing the genuine article, then the similitude is such as entitles the injured party to equitable protection, if he takes seasonable measures to assert his rights, and to prevent their continued invasion." (Citing cases)

SUMMARY

The Patent Office is the administrative agency charged with the responsibility for executing the trademark registration statutes. Where a review of the administrative proceeding is had under appropriate statutes "the courts are simply not authorized to substitute their own views" (R. 9) for those of the Patent Office. "The question is whether the expert agency charged with responsibility in the matter has in view of all the evidence clearly erred in finding that the possibility of confusion exists" (R. 9) and concludes therefrom that the newcomer is not entitled to a registration under the applicable Trademark Act (in this case, the Act of 1905).

As pointed out above, the Patent Office had before it a complete record, based on testimony and physical exhibits. From this record the Patent Office considered *all* elements which might render confusion likely, only one of those elements being "confusing similarity of the marks themselves. It considered the elements of priority of use and registration, similarity of goods,

methods of merchandising, classes of purchasers and readily resolved all of these issues in favor of repondent. As to the remaining facet, "confusing similarity" of the marks UNIVIS and SUNVIS, the Patent Office followed the "one element" criterion of the Court of Customs and Patent Appeals. In the ensuing civil action, the Court of Appeals for the District of Columbia Circuit also followed the Court of Customs and Patent Appeals, as well as its own precedents, and agreed with the conclusion reached by the Executive Branch of the Government as represented by the Patent Office.

Coming finally to the question of presumption of correctness of the rulings of an expert agency of the Executive Branch of the Government, the doctrine of separation of powers has not changed since the Supreme Court rendered its decision in *Morgan* v. *Daniels,* supra, and there is nothing in petitioner's brief to show that Congress has manifested a change in that regard. Indeed, the only reason for providing a judicial review of administrative action is to insure the necessary "check and balance" by which *clear error* on the part of an administrative agency may be corrected. Congress did not intend to substitute for the judgment of the expert administrative body that of the judiciary, in the absence of a miscarriage of justice or, to use the language of the Supreme Court itself in *Morgan* v. *Daniels,* supra; in the absence of evidence "which in character and amount carries thorough conviction" that the decision of the agency is clearly erroneous or that the decision has been reached without any evidentiary basis whatever.

In view of the foregoing, respondent respectfully prays that the petition be denied.

Respectfully,

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